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ATTORNEY DOCKET NO. CONFIRMATION NO. FILING DATE FIRST NAMED INVENTOR APPLICATION NO. 10/609,471 07/01/2003 Reiko Ueno OGOH: 123A 1068 EXAMINER 27890 7590 12/13/2005 STEPTOE & JOHNSON LLP BLENMAN, AVALON 1330 CONNECTICUT AVENUE, N.W. ART UNIT PAPER NUMBER WASHINGTON, DC 20036 2153

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)
Office Anti-en Occurrence	10/609,471	UENO ET AL.
Office Action Summary	Examiner	Art Unit
	Avalon Blenman	2153
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the c	orrespondence address
A SHORTENED STATUTORY PERIOD FOR REPL' WHICHEVER IS LONGER, FROM THE MAILING D. Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).
Status		
1) Responsive to communication(s) filed on 01 Ju 2a) This action is FINAL. 2b) This 3) Since this application is in condition for alloward closed in accordance with the practice under E	s action is non-final.  nce except for formal matters, pro	
Disposition of Claims		
4)  Claim(s) 11-20 is/are pending in the application 4a) Of the above claim(s) 1-10 is/are withdrawn 5)  Claim(s) is/are allowed. 6)  Claim(s) 11-20 is/are rejected. 7)  Claim(s) 17-20 is/are objected to. 8)  Claim(s) are subject to restriction and/o  Application Papers  9)  The specification is objected to by the Examine 10)  The drawing(s) filed on is/are: a) acc Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11)  The oath or declaration is objected to by the Examine 110  The oath or declara	or election requirement.  er. epted or b) objected to by the larawing(s) be held in abeyance. Section is required if the drawing(s) is objected.	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority document application from the International Bureau * See the attached detailed Office action for a list	es have been received. Es have been received in Application rity documents have been received in PCT Rule 17.2(a)).	on No ed in this National Stage
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12/01/2005.	4) Interview Summary Paper No(s)/Mail D: 5) Notice of Informal P -6) Other:	

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#### **DETAILED ACTION**

1. This office action is a <u>first action</u> on the merits of this application and is made **NON-FINAL**. Claims 11-20 are currently pending, of which 11, 12, 13, 15, 17 & 19 are independent claims. Claims 1-10 have been cancelled. Claims 11-20 have been added.

## Response to Amendment

2. Preliminary amended submitted 07/01/2003 has been entered.

### **Double Patenting**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

4. Claim 11 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over both claims 11 & 15 of copending Application No. 10/220,055. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 11 of the instant application is anticipated by claims 11 & 15 the of copending application in that claims 11 & 15 of the copending application contain all the limitations of claim 11 of the instant application.

### Instant application 10/609,471

### Copending Application 10/220,055

- 11. A method of transmitting data from an appliance connected to a first network among a plurality of networks, the method comprising:
  - transmitting <u>all data for a network</u> other than the first network only to a particular router which is one router among a plurality of routers connected to the first network.
- 11. A method of routing data through a router connected to a plurality of networks, the method comprising:
  - transmitting <u>data for networks other</u> than a first network only to a particular router that is one router among a plurality of routers connected to the first network.

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11. A method of transmitting data from an appliance connected to a first network among a plurality of networks, the method comprising:

- transmitting <u>all data for a network</u> other than the first network only to a particular router which is one router among a plurality of routers connected to the first network.
- 15. A method of routing data through a router connected to a plurality of networks that include a first network to which an appliance is connected, the method comprising:
  - transmitting all data to be

    transmitted to an appliance having
    identification information showing a
    network different from the first
    network to a particular router that is
    one router among a plurality of
    routers connected to the first
    network.
- 5. Claims 12 & 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over both claims 11 & 15 of copending Application No. 10/220,055. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 12 & 17 of the instant application are anticipated by claims 11 & 15 of the copending application in that claims 11 & 15 of the copending application inherently contain all the limitations of claims 12 & 17 of the instant application.

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## Instant application 10/609,471

## Copending Application 10/220,055

- 12. An appliance connected to a first network among a plurality of networks, the appliance comprising:
  - means for stipulating a particular
     router among a plurality of routers
     connected to the first network; and
  - means for transmitting <u>all data for a</u>
     <u>network</u> other than the first network
     to the particular router.

- 11. A method of routing data through a router connected to a plurality of networks, the method comprising:
- [--It is inherent that in order to transmit data to the particular router, "stipulating a particular router" is an essential feature.--]
  - transmitting data for networks other than a first network only to a particular router that is one router among a plurality of routers connected to the first network.
- 17. A method of transmitting data from a first appliance connected to a first network among a plurality of networks, the first appliance having identification information indicating the first network, the method comprising:
  - stipulating a particular router among
     a plurality of routers connected to
     the first network; and
- 15. A method of routing data through a router connected to a plurality of networks that include a first network to which an appliance is connected, the method comprising:

[--It is inherent that in order to transmit data to the particular router, "stipulating a particular router" is an essential feature.--]

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transmitting <u>data for a second</u>
 <u>appliance</u> having identification
 information indicating a network
 different from the first network only
 to the particular router.

- transmitting all data to be
  transmitted to an appliance having
  identification information showing a
  network different from the first
  network to a particular router that is
  one router among a plurality of
  routers connected to the first
  network.
- 6. Claims 13 & 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over both claims 11 & 15 of copending Application No. 10/220,055. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13 & 15 of the instant application are anticipated by claims 11 & 15 of the copending application in that claims 11 & 15 of the copending application inherently contain all the limitations of claims 13 & 15 of the instant application.

### Instant application 10/609,471

# Copending Application 10/220,055

13. A method of transmitting data from an appliance connected to a first network among a plurality of networks, the method comprising:

11. A method of routing data through a router connected to a plurality of networks, the method comprising:

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 transmitting data for a network other than the first network only to a particular router which is one router among a plurality of routers connected to the first network wherein, transmitting <u>data for networks</u> other than a first network only to a particular router that is one router among a plurality of routers connected to the first network.

the data comprises identification
 information of the particular router
 as address information within the
 first network.

[--It is inherent that in order to transfer data to a particular router, the identification information of the particular rounder must be contained in the data being transferred (i.e. destination address in the header/metadata of the data being transferred).--].

- 15. An appliance connected to a fist network among a plurality of networks, the appliance comprising:
- 15. A method of routing data through a router connected to a plurality of networks that include a first network to which an appliance is connected, the method comprising:
- transmitting <u>data for a network other</u>
   <u>than the first network</u> only to a
   particular router which is one router
   among a plurality of routers
- transmitting <u>all data to be</u>
   <u>transmitted to an appliance having</u>
   <u>identification information showing a</u>
   <u>network different from the first</u>

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connected to the first network wherein,

the data comprises identification
 information of the particular router
 as address information within the
 first network.

network to a particular router that is one router among a plurality of routers connected to the first network.

[--It is inherent that in order to transfer data to a particular router, the identification information of the particular rounder must be contained in the data being transferred (i.e. destination address in the header/metadata of the data being transferred).--].

7. Claims **18 & 20** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over both claims 16 & 18 of copending Application No. 10/220,055. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 18 & 20 of the instant application are anticipated by claims 16 & 18 of the copending application in that claims 16 & 18 of the copending application inherently contain all the limitations of claims 18 & 20 of the instant application as transmitting data directly to "a transmitting end appliance" and transmitting data directly to "the third appliance" is functionally equivalent.

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18.

transmitting data <u>for a third</u>
 <u>appliance</u> having identification
 information indicating a network
 same as the first network directly to
 the third appliance

16.

transmitting data directly from an appliance connected to the first network to a transmitting end appliance when identification information of a network of the transmitting end appliance is the same as identification information of the network to which the appliance belongs.

20.

means for transmitting <u>data for a</u>
 <u>third appliance</u> having identification
 information indicating a network
 same as the first network directly to
 the third appliance

18.

an appliance connected to the first network is for transferring data directly to the transmitting end appliance when identification information of a network of transmitting end appliance is same as identification information of the network to which the appliance belongs.

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8. Claim **19** is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over both claims 11 & 15 of copending Application No. 10/220,055. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 19 of the instant application is anticipated by claims 11 & 15 of the copending application in that claims 11 & 15 of the copending application inherently contain all the limitations of claim 9 of the instant application.

#### Instant application 10/609,471

## Copending Application 10/220,055

- 19. An appliance connected to a first network among a plurality of networks, the appliance comprising:
  - means for holding <u>identification</u>
     <u>information of the first network;</u>
  - means for stipulating a plurality
     router among a plurality of routers
     connected to the first network; and
  - means for transmitting data for a second appliance having

- 11. A method of routing data through a router connected to a plurality of networks, the method comprising:
  - holding all router information in the particular router, the information denoting <u>connection information of</u> <u>all routers</u>;

[--It is inherent that in order to transmit data only to the particular router, "stipulating a particular router" is an essential feature.--]

transmitting <u>data for networks other</u>
 <u>than a first network</u> only to a

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identification information indicating a network different from the first network only to the particular router.

particular router that is one router among a plurality of routers connected to the first network;

- 19. An appliance connected to a first network among a plurality of networks, the appliance comprising:
- 15. A method of routing data through a router connected to a plurality of networks that include a first network to which an appliance is connected, the method comprising:
- means for holding <u>identification</u>
   <u>information of the first network;</u>
- holding all router appliance information in the particular router, the information denoting <u>connection</u> information of all routers;
- means for stipulating a plurality
   router among a plurality of routers
   connected to the first network; and
- [--It is inherent that in order to transmit data only to the particular router, "stipulating a particular router" is an essential feature.--]
- means for transmitting data for a second appliance having identification information indicating a network different from the first network only to the particular router.
- transmitting all data to be

  transmitted to an appliance having
  identification information showing a
  network different from the first
  network to a particular router that is
  one router among a plurality of

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routers connected to the first	
<u>network</u> .	

## **Priority**

9. Acknowledgment is made of applicant's claim for priority to PCT/JP00/09366. Although the international application was filed on or after November 29, 2000 and designates the United States, an English translation under PCT Article 21(2) was not provided. Applicants are required to send a certified translation of the PCT/JP00/09366 in order to claim right of priority. Until this condition is met, the effective filing date for the subject matter defined in the pending claims is August 27<sup>th</sup>, 2002.

#### Information Disclosure Statement

10. The formation disclosure statement (IDS) submitted by applicant has been entered and is being considered by the examiner.

## Specification

- 11. The abstract of the disclosure is objected to because it is replete with grammatical errors. Correction is required. See MPEP § 608.01(b). For example:
  - (a) The phrase "connected one another" (lines 2-3) should read: connected to one another.
  - (b) The phrase "a particular router having information about all the connections of other networks than the each network" (lines 7-8) is unclear.

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(c) The phrase "the particular router establishes an appropriate route for transmission, as considering the actual states of the networks" (lines 10-12) is unclear.

- 12. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:
  - (a) The phrase "in the summer season, water heater..." should read: in the summer season, a water heater... (pg. 1, line 24).
  - (b) The phrase "heat resources that are being in operation" is unclear (pg. 2, line 9).
  - (c) The "(" after the word function should be removed (pg. 3, line 19).
- 13. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

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14. Claim **17** is objected to because of the following informalities: The extra space between "networks" and "the" should be deleted (line 3). Appropriate correction is required.

- 15. Claims **18 & 20** are objected to because of the following informalities: The phrase should read: "a network *which is the* same as the fist network" (lines 4 & 4, respectively). Appropriate correction is required.
- 16. Claim **19** is objected to because of the following informalities: The word "plurality" should be deleted between "a" and "router" (line5) so the phrase reads: means for stipulating a plurality router among a plurality of routers. Appropriate correction is required.

#### Claim Rejections - 35 USC § 112

- 17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

  The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 18. Claims **14 & 16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "receiver identification information comprising identification information of a network of a transmitting end appliance and identification information of the transmitting end appliance" (lines 6-9, 5-8, respectively) is indefinite. Should the phrase read: receiver identification information comprising

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identification information of a network of a *receiving* end appliance and identification information of the *receiving* end appliance? Appropriate clarification is required. The claims will be treated as best understood by Examiner.

## Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 20. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by **Maciel et al** (US 6,112,248), hereinafter Maciel.
- 21. In considering independent claim 11, Maciel discloses a method of routing data through a router connected to a plurality of networks, the method comprising:
  - transmitting all data for a network (fig. 1, #2 & #5) other than a first network (fig. 1, #1) only to a particular router (3a, "data processing device") which is one router among a plurality of routers connected to the first network [col. 1, lines 22-33, 41-52, col. 2, lines 18-36];

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22. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by **Basso et al.** (US 6,658,481), hereinafter Basso.

- 23. In considering independent claim 11, Basso discloses a method of routing data through a router connected to a plurality of networks, the method comprising:
  - transmitting all data for a network (fig. 2, #40a & 40b) other than a first network (fig. 2, #30) only to a particular router (fig. 2, R5) which is one router among a plurality of routers connected to the first network [col. 1, lines 31-38];
- 24. Claims **12**, **13**, **15**, **17-20** are rejected under 35 U.S.C. 102(e) as being anticipated by **Balassanian** (US 2005/0021857), hereinafter Balassanian.
- 25. In considering independent claim **12**, Balassanian discloses an appliance connected to a first network among a plurality of networks, the appliance comprising:
  - means for stipulating a particular router ("network address of gateway") among a
    plurality of routers ("series of hops") connected to the first network (fig. 1b, #160,
    WAN) [¶0037, ¶0048]; and
  - means for transmitting all data for a network other than the first network (fig. 1b, #195, LAN) to the particular router (fig. 1b, #165, "gateway") [¶0037, ¶0048].

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26. In considering independent claims **13 & 15**, Balassanian discloses a method of transmitting data from an appliance connected to a first network among a plurality of networks, the method comprising:

- transmitting data for a network other than the first network (fig. 1b, #195, LAN) only to a particular router (fig. 1b, #165, "gateway") which is one router among a plurality of routers ("series of hops") connected to the first network (fig. 1b, #160, WAN) [¶0037, ¶0048]., wherein,
- the data comprises identification information of the particular router ("network address of gateway") as address information within the first network [¶0037, ¶0048]..
- 27. In considering independent claim **17**, Balassanian discloses a method of transmitting data from a first appliance connected to a first network among a plurality of networks, the first appliance having identification information indicating the first network, the method comprising:
  - stipulating a particular router ("network address of gateway") among a plurality of routers ("series of hops") connected to the first network(fig. 1b, #160, WAN)
     [¶0037, ¶0048]; and
  - transmitting data for a second appliance (fig. 1b, #175-190) having identification information indicating a network different from the first network (fig. 1b, #195, LAN) only to the particular router (fig. 1b, #165, "gateway") [¶0037, ¶0048].

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28. In considering claims 18 & 20, Balassanian discloses:

transmitting data for a third appliance having identification information indicating a network same as the first network directly to the third appliance [fig. 8, step 815, ¶0045, claim 1].

- 29. In considering independent claim **19**, Balassanian discloses an appliance connected to a first network among a plurality of networks, the appliance comprising:
  - means for holding identification information of the first network [fig. 2, "Table of Known Appliances, ¶0037];
  - means for stipulating a plurality router ("network address of gateway") among a
    plurality of routers ("series of hops") connected to the first network (fig. 1b, #165,
    WAN) [¶0037, ¶0048]; and
  - means for transmitting data for a second appliance (fig. 1b, #175-190) having identification information indicating a network different from the first network (fig. 1b, #195, LAN) only to the particular router (fig. 1b, #165, "gateway") [¶0048].

# Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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31. Claims **14 & 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Balassanian**, further in view of **Teraoka (US 6,292,836)**.

- 32. In considering claims **14 & 16**, while Balassanian discloses a method of transmitting data from a first network to another network via a router, Balassanian does not explicitly disclose the detailed contents of the data. Nonetheless in analogous art, Teraoka discloses a method of transmitting data from a first network to another network via a router (fig. 1, col. 4, lines 22-34). Teraoka further discloses:
  - the data further comprises transmitter identification information comprising identification information of a network of the appliance ("transmitting host address") and identification information of the appliance ("transmitting host identifier") and receiver identification information comprising identification information of a network of a transmitting end appliance ("receiving host address") and identification information of the transmitting end appliance ("receiving host identifier") [fig.2, col. 4, lines 22-34].; and
  - the transmitter identification information and the receiver identification information are provided in a data region ("header") of the data [fig.2, col. 4, lines 22-34].

Given the teachings of Teraoka, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system/method disclosed by Balassanian where a data region of the data would contain identification information.

The motivation, as suggested by Teraoka, would be so that the identification information

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could be read by the routers transited by the data and forwarded to the appropriate destination [col. 4, lines 22-34].

#### Conclusion

- 33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- 34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avalon Blenman whose telephone number is (571) 272-5864. The examiner can normally be reached on Mon-Fri, 7:00 AM 4:30 PM (even date Mons. off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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